UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,113	08/15/2001	James E. King	5681-04100	9999

7590 05/23/2006	**EXAMINER**
B. Noel Kivlin Conley, Rose, & Tayon, P.C. P.O. Box 398 Austin, TX 78767	POPHAM, JEFFREY D

ART UNIT	PAPER NUMBER
2137	

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Advisory Action *Before the Filing of an Appeal Brief*	Application No. 09/930,113	Applicant(s) KING ET AL.	
	Examiner Jeffrey D. Popham	Art Unit 2137	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED <u>20 April 2006</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

   a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

      Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

<u>NOTICE OF APPEAL</u>

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

<u>AMENDMENTS</u>

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

   (a)☐ They raise new issues that would require further consideration and/or search (see NOTE below);

   (b)☐ They raise the issue of new matter (see NOTE below);

   (c)☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d)☐ They present additional claims without canceling a corresponding number of finally rejected claims.

      NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1-31*.

   Claim(s) withdrawn from consideration: _____.

<u>AFFIDAVIT OR OTHER EVIDENCE</u>

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

<u>REQUEST FOR RECONSIDERATION/OTHER</u>

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.

EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER

Continuation of 7. Claims 1-31 will be rejected in the same manner as in the final rejection, as the amendment only fixes some errors (i.e., changing "to read" to "reading" to correspond to the rest of claim 20) and does not change the scope of the claims

Continuation of 11. does NOT place the application in condition for allowance because: Applicants argue that the motivation used to combine Walters with Merrien ("to verify that the card input to the system was an approved card that could be used with the system") is not found within the cited references. This motivation is, indeed, found in Walters. Column 2, lines 31-35 describe how only the proper (approved) memory card can be used for a particular application. Column 2, line 60 to Column 3, line 3 describe how it is verified that the card is an approved card that can be used with the system, as does the cited section (Column 4, line 62 to Column 5, line 51). Applicants argue that the protection code of Waters is strictly for internal use, and that making this protection code public would teach away from Merrien. The examiner fully admits that the protection code of Walters is strictly for internal use ("the protection code does not supply any information which is used outside of the authorization procedure"). Within the combination, the card is first authorized by using the write-then-read method of Walters. Only then, can other data be accessed on the card. This other data comprises the network identity of Merrien. Merrien discloses that data will only be read from (or written to) the card after access conditions have been met via use of a cryptographic code (protection code of Walters) and authentication of the card (Page 10, lines 16-28). Once the card has been appropriately authenticated and authorized, the network identity can be read from the card. Applicant argues that there is no teaching of how to combine the elements of Merrien with the elements of Walters, and that the references teach away from each other. As described above, and as described in the final office action, this is incorrect, since the card is authorized via the method of Walters (cited sections, at least), and Merrien teaches the reading of the supplied network identity, as well as the other parts of claim 1. As described by applicant, "Merrien discloses a method and system for using a smart card capable of being inserted in a terminal" and "Walters discloses a memory card (such as a PCMCIA card) which protects against unauthorized copying and use of software saved on the card". The combination protects the smart card that is inserted into Merrien's terminal against unauthorized reading, writing, copying, and/or use of the data stored thereon by first undergoing the authorization scheme of Walters. Applicant argues that there is no teaching or suggestion in Walters that verification of the protection code permits the reading of arbitrary data (i.e., data other than the executed software, such as the network identify in Merrien) from the card. As recited in Walters, claim 1, "read-write memory means for storing data and application programs". As can clearly be seen by this section, Walters does teach the storage and access control of data other than application programs, which in the combination of Merrien-Walters, is at least the network identity.